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In re Application of :
ENDO *et al* :
U.S. Application No.: 10/510,245 :
PCT No.: PCT/JP03/04751 :
Int. Filing Date: 15 April 2003 :
Priority Date: 16 April 2002 :
Attorney Docket No.: 040474 :
For: RESIST REMOVING APPARATUS :
AND METHOD OF MOVING RESIST :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 28 June 2005.

BACKGROUND

On 04 April 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 28 June 2005, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a one-month extension; a declaration signed by two of the three named inventors; a \$130.00 petition fee; and a statement by Mr. Kokubun.

On 19 July 2005, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt indicating that the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and date of completion of all 35 U.S.C. 371 requirements is 28 June 2005.

On 12 October 2006, a request for status was mailed.

DISCUSSION

Applicants claim that they have been unable to locate Mr. Atsushi Sato and filed the petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 04 April 2005. A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or

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declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Applicants completed items (1) and (3) with this petition.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Petitioners submitted a \$130.00 petition fee on 28 June 2005. The \$70.00 difference will be charged to Deposit Account No. 01-2340 as authorized. Item (1) of 37 CFR 1.47(a) is complete

With regards to item (3), the last known address of co-inventor Atsushi Sato is listed as:

1-18-208, Kouya 2-chome,
Ichikawa-shi, Chiba272-0013
Japan

Regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants submitted a statement of facts by Mr. Kokubun who claims that the nonsigning inventor cannot be located. Mr. Kokubun states that a letter sent to the last known address of the nonsigning inventor was returned as being undeliverable. Moreover, attempts were made to contact Mr. Sato by telephone, email and facsimile to no avail. Finally, an inquiry was made at the last known work office was made. Petitioners said that they found out that Mr. Sato had retired and no one at his office had useful information to locate him.

This evidence is insufficient to show that a "diligent effort" was made to locate the nonsigning inventor. There is no evidence that petitioners attempted to locate Mr. Sato using the internet or a telephone directory. These efforts are not extraordinary

and should be made to demonstrate that a diligent effort was made to locate the nonsigning joint inventor. Moreover, copies of the items mailed 27 September 2004 were not included in the petition despite the claim in paragraph 3 of the declaration by Mr. Kokubun. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached must be submitted with any renewed petition.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the four co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, mailing address and citizenship of all three inventors are recorded on the declaration as required.

However, the declaration contains foreign language text, but it is not a USPTO form and is not accompanied by a statement that the English text is an accurate translation of the foreign text. See 37 CFR 1.69. As such, the declaration cannot be accepted and item (4) of 37 CFR 1.47(a) is also not satisfied.


CONCLUSION

For the reasons noted above, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt mailed 19 July 2005 were sent in error and hereby **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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